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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,932	10/30/2003	James F. McGuckin JR.	1255	1044
7590	11/20/2007		EXAMINER	
NEIL D. GERSHON REX MEDICAL 1011 HIGH RIDGE RD Stamford, CT 06905			SHAFFER, RICHARD R	
			ART UNIT	PAPER NUMBER
			3733	
			MAIL DATE                    DELIVERY MODE	
			11/20/2007                    PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/696,932	MCGUCKIN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Richard R. Shaffer	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 04 September 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-9 and 11-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-9 and 11-18 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date: _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/4/2007</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|   | 6) <input type="checkbox"/> Other: _____.                         |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9 and 11-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1, 12 and 18 all recite the limitation "non-occluding." The specification as originally disclosed did not state that applicant's device could not or would not ever occlude. Therefore it is deemed new matter.

Claim 11 recites, "a portion of the strut parallel to the longitudinal axis ..." is not supported by the disclosure as originally filed. Throughout the specification, it was always stated that struts extended **substantially** parallel.

Claim 12 recites, "the struts in the mounting section having a parallel component parallel ..." Again, applicant does not have support to claim parallel, only substantially parallel.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

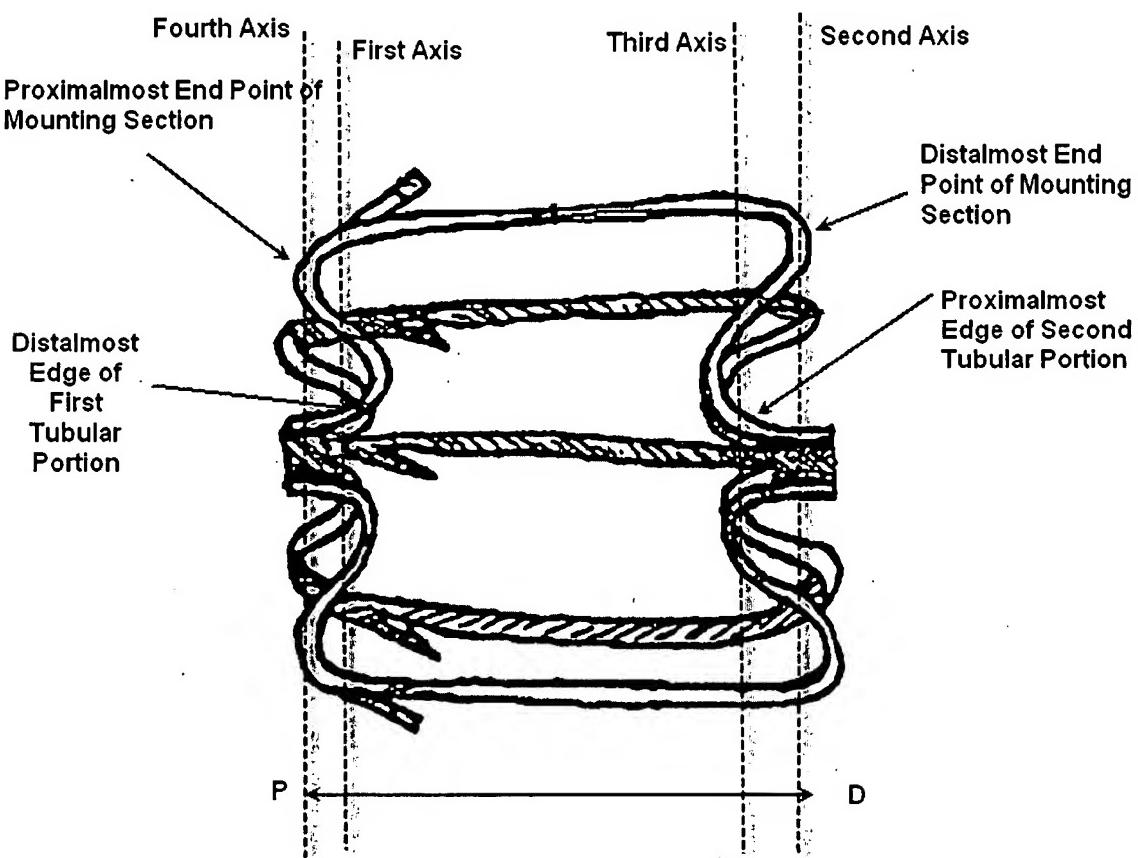
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 9, 11-14, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bosma et al (US Patent 6,443,972) in view of van der Burg et al (US Patent 6,994,092).

Bosma et al disclose a vessel filter (**Figures 5 and 8-9C**) and method (**Figure 1**) comprising: a mounting section (middle section) having a proximal and distal end; two filtering sections (angled portions converging at tubular sections); the filtering sections defined by a plurality of longitudinal struts with ribs connecting adjacent struts; the device is self-expanding Nitinol (**Column 4, Lines 11-15**); the struts are spaced circumferentially about 60 degrees apart; a plurality of vessel engaging members (**27**) and/or roughening (**Column 6, Lines 52-53**); and the struts (in **Figure 8**) have an angled portion with a width less than the width of the straight portion of the mounting section.

Bosma et al disclose all of the claimed limitations except for the specific structure and location of the filtering section with regard to the mounting section. van der Burg et al teach (**Figure 35; Column 18, Lines 34-55**) that an expandable device for placement against a bodily tubular structure with an S-shape end portion provides an elongated mounting section which improves contact area. It would have been obvious to one

having ordinary skill in the art at the time of invention to design the filter of Bosma et al according to the structure taught in van der Burg et al in order to improve fixation within the blood vessel. In regard to applicant's extensive claim language defining the relationship between the filter section and mounting section, see the Figure below depicting how the structure of van der Burg et al meets the claimed limitations.



Claims 8, 15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bosma in view of van der Burg et al and in further view of Gilson et al (US Patent Application Publication 2002/0058911).

The combination of Bosma and van der Burg et al disclose and teach all of the claimed limitations except for struts out of phase. Gilson et al teach in Figures 15-22

out of phase struts as an appropriate structure for forming an expandable structure to act as an embolic filter. It would have been obvious to one having ordinary skill in the art at the time the invention was made to design the combination of Bosma and van der Burg et al with out of phase struts as a matter of mere substitution for providing an expandable embolic filter with predictable results.

***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

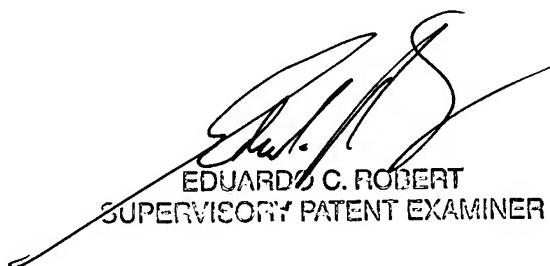
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard R. Shaffer whose telephone number is 571-272-8683. The examiner can normally be reached on Monday-Friday (7am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Richard Shaffer  
November 16<sup>th</sup>, 2007



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER